



REMARKS

Applicants have carefully reviewed the Office Action dated March 15, 2005, and respectfully request reconsideration in view of the foregoing amendments and the following remarks.

Applicants note that the application contains Claims 25-65. Claims 1-24 were canceled and Claims 25-65 were added in the Supplemental Preliminary Amendment dated November 6, 2001.

Claims 25 and 41 have been amended to delete provision (C2) and also to require that polyaddition compound B) is based on at least one aliphatic and/or cycloaliphatic diisocyanate. Support for this amendment is found in paragraph 0015 of the specification. The other amendments to Claims 25 and 41 and the remainder of the claims were made to correct obvious typographical errors and to more fully comply with U.S. claims practice.

Claims 25-63 have been rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The Examiner contends that for Claims 25 and 41, the specification does not provide enablement for the (C1) and (C2) provisions set forth in these claims. There does not appear to be support for the exclusion of Lewis acid carboxylates as catalysts for only the specific instances of (A1) and (A2). In addition, the support for (C2) is not apparent from the specification.

Applicants submit that the rejection with regard to provision (C2) has been overcome by deleting this provision from the claims. With regard to the rejection over provision (C1) Applicants submit that this provision is supported by the decision reached in In re Johnson and Farnham, 194 USPQ 187 (CCPA 1977). In this case the claims were also rejected as being broader than the enabling disclosure because Applicants had excluded two species from the claims that were originally disclosed as being part of the invention. At page 195 the CCPA stated the issue as follows: "The only inquiry is whether, after exclusion from the original claims of two species specifically disclosed in the 1963 application, the 1963 disclosure satisfies §112, first paragraph, for the "limited genus" now claimed." The CCPA found more than ample basis for the "limited genus" in Claim 1.

The CCPA continued by stating that inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable. To deny appellants the benefit of their grandparent application in this case would eliminate the right of an applicant to retreat to an otherwise patentable species merely because he erroneously thought he was first with the genus when he filed.

Applicants submit that the fact pattern in Johnson is the same as in the subject application. The specification clearly discloses that Lewis acid catalysts, in particular Lewis acid carboxylates, could be used in combination with limitations (A1), (A2) and (A3), i.e., when bonding agent (A) contains no carboxyl groups, has a concentration of carboxyl groups that is less than the concentration of active catalyst or has a concentration of carboxyl groups that is greater than the concentration of active catalyst. The claims now require that when the limitations (A1) or (A2) are met, Lewis acid carboxylates are excluded as catalysts. Accordingly, based on the decision reached in Johnson, Applicants submit that the subject claims are properly enabled and in compliance with 35 USC 112, first paragraph.

For the preceding reasons, withdrawal of this rejection is requested.

Claims 25-30, 39-46, 50, 54, 55 and 59-63 have been rejected under 35 USC 102(b) as being anticipated by U.S. Patent 4,442,280 to Grogler et al.

Applicants' traverse this rejection in view of the amendments to the subject claims to require polyaddition compound B) to be based on at least one aliphatic and/or cycloaliphatic diisocyanate. To the contrary Grogler et al requires the polyaddition compounds to be uretdiones based on 4,4'-diisocyanato-diphenyl methane, which is an aromatic diisocyanate (Note the Abstract; column 4, lines 66-68 and the formula at column 5). Because Grogler et al does not disclose uretdiones prepared from aliphatic and/or cycloaliphatic diisocyanates as required by the subject claims, it is submitted that this reference fails to anticipate the subject claims. Accordingly, withdrawal of this rejection is requested.

Claims 47, 49, 51, 52, and 56-68 have been rejected under 35 USC 103(a) as being unpatentable over U.S. Patent 4,442, 280 to Grogler et al.

Applicants traverse this rejection for the reasons set forth above with regard to the anticipation rejection, i.e., that Grogler et al does not disclose uretdiones based on aliphatic and/or cycloaliphatic diisocyanates as required by the subject claims. In addition, Applicants submit that it would not be obvious to modify the teachings of Grogler et al to use the claimed uretdiones because the entire reference is directed to the use of 4,4'-diisocyanato-diphenyl methane, an aromatic diisocyanate, to prepare the uretdione polyaddition compounds. For these reasons it is submitted that Grogler et al fails to render the subject claims unpatentable in accordance with 35 USC 103(a). Accordingly, withdrawal of this rejection is respectfully requested.

The foregoing is believed to be a complete response to the Office Action dated March 15, 2005, and in view of the preceding amendments and remarks, a Notice of Allowance is respectfully requested.

Respectfully submitted,

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